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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/857,618	06/07/2001	Katsuyuki Yomogida	IWA-171-PCT	5189

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EXAMINER
COLE, MONIQUE T

ART UNIT	PAPER NUMBER
1743	5

DATE MAILED: 09/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/857,618	YOMOGIDA ET AL.	
	Examiner	Art Unit	
	Monique T. Cole	1743	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *07 June 2001* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-11* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-3,5,6 and 8-10* is/are rejected.

7)☒ Claim(s) *4, 7, 11* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☒ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *4* .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Priority

1. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Japan on 5/31/2000. It is noted, however, that applicant has not filed a certified copy of the JP 00/03522 application as required by 35 U.S.C. 119(b).

Claim Objections

2. Claims 1 and 3 are objected to because of the following informalities:

- In claim 1, "with" should be changed to "which";
- In claim 1, a period should be added at the end of the sentence;
- In claim 3, line 3, "to" should be changed to "in an" & "and get" should be changed to "to obtain".

Appropriate correction is required.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 1-3 rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over USP 4,847,422 to Klemola et al. (herein referred to as "Klemola").

Klemola teaches a method for the production of vanillin in the form of a very pure product by oxidizing lignin contained in the wood pulping liquor (solvent). The separation & purification of vanillin from the reaction mixture is carried out by means of an extraction at a supercritical pressure & temperature (vapor-phase). Carbon dioxide can be used as an extraction gas (inert gas). The vanillin is extracted from the oxidized waste liquor by means of overpressurized carbon dioxide (forcible discharge). See abstract; col. 1, line 66-col. 2, line 1.

With regard to the extraction process taught by Klemola, all of the limitations of the claim except vanillin's use as a fragrance ingredient are present. However, it is the Examiner's position that this property would be inherent to the extraction of vanillin, as this compound is conventionally known as a pleasant fragrance material and necessarily possesses this characteristic, absent any evidence to the contrary. A rejection under 35 USC 102/103 can be properly made when the prior art process seems to be identical except that the prior art is silent as to an inherent characteristic. See MPEP 2112.

2. Claims 5 & 9 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Fournet.

Fournet teaches a liquid vanillin composition well suited as perfuming agents for a wide variety of applications including cosmetics and perfumes comprising vanillin, ethylvanillin and an aqueous and/or organic solvent therefor. See abstract. This composition has the same components as that instantly claimed by Applicant.

Fournet teaches the invention substantially as claimed with the exception of being produced by the process as recited in claim 1. However, once a product appearing to be

substantially identical is found, although produced by a different process, the burden shifts to Applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of the product does not depend on its method of production. If the product in the product-by-process is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. See MPEP 2113.

3. Claims 5, 6 & 8 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over USP 4,444,982 to Nagashima et al. (herein referred to as "Nagashima").

Nagashima teaches a fragrance ingredient, 7-hydroxy-2,6,6-trimethyltricyclo-[6,2,1,$0^{1,5}$]undecane, obtained from agar oil. The obtained compound has the characteristic odor of agarwood and may be compounded in various perfume compositions (col. 4, lines 14-28).

Nagashima teaches the invention substantially as claimed with the exception of being produced by the process as recited in claim 1. However, once a product appearing to be substantially identical is found, although produced by a different process, the burden shifts to Applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of the product does not depend on its method of production. If the product in the

product-by-process is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. See MPEP 2113.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham* v. *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. Claims 5, 6, 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Klemola in view of USP 5,895,657 to Fournet et al. (herein referred to as "Fournet").

Klemola fails to teach the vanillin as a component of a perfume composition or cosmetic composition.

However, Fournet teaches that vanillin is well suited & conventionally known to be an ingredient in cosmetics & perfumes. Vanillin is known to many because of its pleasant scent.

Thus, given the conventional use of vanillin in cosmetics and perfumes and its recognized pleasant scent, as taught by Fournet, it would have been obvious to one of ordinary skill in the art to utilize the vanillin obtained in Klemola in cosmetic and perfume compositions for the purpose of obtaining a pleasantly fragrances perfume or cosmetic product. Therefore, for the reasons set forth above Applicant's claimed invention is deemed to be obvious, within the meaning of 35 USC 103, over Klemola in view of Fournet.

Allowable Subject Matter

7. Claims 4, 7 & 11 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

8. The following is a statement of reasons for the indication of allowable subject matter: the prior art does not teach or suggest: a method of collection of fragrance ingredient which comprises extracting an essential oil ingredient by solvent from agarwood and collecting the fragrance ingredient in vapor-phase by heating the extract; a perfume or cosmetic composition wherein a ratio by weight of the fragrance collection liquid and the fragrance wood extract is 0.25 to 9.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monique T. Cole whose telephone number is 703-305-0447. The examiner can normally be reached on Monday-Thursday from 6:30 A.M. to 4:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 703-308-4037. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-0661.

Monique T. Cole
Examiner
Art Unit 1743

MC MC